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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,197	12/03/2003	R. Bharat Rao	2002P19745US01	4681

7590

04/08/2005

Siemens Corporation  
Intellectual Property Department  
170 Wood Avenue South  
Iselin, NJ 08830

EXAMINER
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FRENEL, VANEL

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/727,197

Applicant(s)

RAO ET AL.

Examiner

Vanel Frenel

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Amendment filed on 12/09/04. Claims 1, 25 and 39 have been amended. Claims 1-42 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts, and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-38 recite an abstract idea. The recited steps obtaining a medical record of a patient, wherein the medical record comprises patient

information from one or more structured and unstructured data sources does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces one or more structured and unstructured data sources (i.e., repeatable) by analyzing the patient information in the medical record using domain-specific criteria (i.e., useful and tangible).

Looking at claims 1-38 as a whole, nothing in the body of the claims recites any structure or functionality to suggest that a computer performs the recited steps.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-38 are deemed to be directed to non-statutory subject matter.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (6,347,329), (Managed Care: New Financial/Practice Strategies to Manage More

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Efficient/ Effectively in a Primary Care Setting by Virginia Smith Harvin; 1998) in view of Hunt et al (5,933,809).

(A) As per claims 1 and 39, Evans and Harvin do not explicitly disclose the limitations of : “with a device”, “from at least the unstructured data source”, “and”, “automatically extracting billing information from the medical record as part of the analysis”.

However, these features are known in the art, as evidenced by Hunt. In particular, Hunt teaches “with a device”, “from at least the unstructured data source”, “and”, “automatically extracting billing information from the medical record as part of the analysis” (See Hunt, Col.7, lines 25-59; Col.9, lines 15-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Hunt within the collective teachings of Evans and Harvin with the motivation of providing a computer software program to automatically screen pre-existing medical billing record information (See Hunt, Col.2, lines 16-19).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(B) As per claim 25, Evans and Harvin do not explicitly disclose the limitations of: “of a device”, “the medical record comprising”, “from at least the unstructured data source”.

However, these features are known in the art, as evidenced by Hunt. In particular, Hunt teaches "of a device", "the medical record comprising", "from at least the unstructured data source" (See Hunt, Col.7, lines 25-59; Col.9, lines 15-45).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Hunt within the collective teachings of Evans and Harvin with the motivation of providing a computer software program to automatically screen pre-existing medical billing record information (See Hunt, Col.2, lines 16-19).

The remaining features are as addressed in the previous Office Action, and incorporated herein.

(C) Claims 2-24, 26-38 and 40-42 have not been amended and are therefore rejected for the same reasons given in the previous Office Action, and incorporated herein.

#### ***Response to Arguments***

6. Applicant's arguments filed on 12/09/04 with respect to claims 1, 25 and 39 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Response to Arguments***

7. Applicant's arguments filed on 12/09/04 with respect to claims 2-24, 26-38 and 40-42 have been fully considered but they are not persuasive. Applicant's arguments

will be addressed hereinbelow in the way they appear in the amendment filed on 12/09/04.

(A) At pages 11-13, Applicant's argues the followings:

(1) Claims 5 and 42 do not disclose "extracting all codes supported by the patient record as a function of all domain-specific criteria. However, the Examiner disagrees.

In response to the above argument, Examiner respectfully suggests that Evans clearly teach such feature in column 8, lines 66 to Col.9, line 19 which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive.

(2) Claims 6 and 7 do not disclose institution-specific domain knowledge used for analysis by a device. However, the Examiner disagrees.

In response to the above argument, Examiner respectfully suggests that Evans clearly teach such feature in column in column 5, lines 2-33 which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive.

(3) Claims 8 and 9 do not disclose do not disclose condition or disease specific knowledge for analyzing the patient record by a device.

In response to the above argument, Examiner respectfully suggests that Evans clearly teach such feature in column in column 5, lines 54-67 to column 6, line 14 which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive.

(4) Claims 10-11, 24, 28 and 29 do not disclose do not disclose point to support information providing the basis for the billing codes.

In response to the above argument, Examiner respectfully suggests that PR Newswire clearly teach such feature in Page 1, Paragraphs 4-5 which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive.

(5) Claims 12-14, 30 and 31 do not disclose do not disclose automatically generate a medical claim patient.

In response to the above argument, Examiner respectfully suggests that PR Newswire clearly teach such feature in Page 1, Paragraphs 4-5 which correspond to Applicant's claimed feature. Therefore, Applicant argument is not persuasive.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches system and method for language extraction and encoding utilizing the parsing of text data in accordance with domain parameters (6,182,029).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday- Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

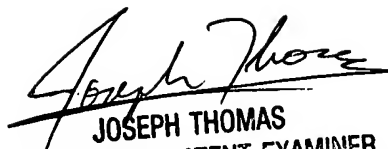
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V.F  
V.F

March 31, 2005

  
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